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APPLICATION NO. 027872,019	FILING DATE 05/15/98	FIRST NAMED INVENTOR ALVAREZ	ATTORNEY DOCKET NO. 1101209
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HM12/0831

EXAMINER DAVENPORT, A

ART UNIT 1553	PAPER NUMBER 13
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DATE MAILED: 08/31/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/079,819

Applicant(s)

ALVAREZ et al

Examiner
Avis M. Davenport

Group Art Unit
1653



☒ Responsive to communication(s) filed on May 3, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-97 is/are pending in the application

Of the above, claim(s) 1-21, 31-39, 41-69, 71, 72, 75-80, and 83-89 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 22, 26-29, 70, 73, 74, 81, and 82 is/are rejected.

☒ Claim(s) 23-25, 30, 40, and 90-97 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. Applicant's election with traverse of Group II in Paper No. ~~1~~ is acknowledged. The traversal is on the ground(s) that to search and examine the subject matter of all the Groups together would not be a serious burden on the Examiner in view M.P.E.P. §803.. This is not found persuasive because the search for each group is different and require extensive database, literature and class subclass searches. The search for all the groups and species which include a multitude of individual sequences would constitute a serious and undue burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 22-30,40,70,73-74,81-82 and 90-97 will be examined in so far as they relate to the elected species HPT1 (seq ID No. 178) and the HPT1 binding peptides SEQ ID Nos. 49-55.

Claims 22,26-29,70,73,81 and 82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are rejected for the following reason:

A. Claims 22,28,29,70,73,74 and 81-82 are rejected as being depended on claims non elected in the instant application. The claims are withdrawn and can not be referred to or relied on for antecedent basis. Please rewrite the claims in independent form.

B. Claim 26 is confusing. The claim drawn to "covalently or noncovalently bound to the material" does not specifically claim the instant subject matter. The term covalently bound to the material is specific and is not objected to or rejected. However the term " noncovalently bound

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to the material is confusing and makes the claim ~~nuclear~~^{unclear}. Please provide further explanation or remove the terminology.

C. Claim 27 is indefinite as to the "second protein. There is no definition of the second protein. Is it the active agent? Please clarify.

D. Claim 27, line 5 of the claim recite "bond" which should be "bound" please correct.

(4) Claim 74 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 74 ~~is~~ dependent on claim 78 which does not constitute a further limitation.

(5) Claims 23-25,30,40 and 90-97 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(6) The claims 22-30,40^{70, 73-74, 81-82} and 90-97 are free from the art in so far as they relate to the elected species HPT1.

Any inquiry concerning this communication should be directed to Avis Davenport at telephone number (703) 308-4002.

Davenport/sg

8-2-00

Avis M. Davenport
AVIS M. DAVENPORT
PRIMARY EXAMINER
GROUP 1800 1653